

REMARKS

Claims 16-21 are currently pending in this application. By this Amendment, claims 16, 17, and 20 have been amended, and new claim 21 has been added. The amended claim set is provided herewith.

Support for the amendments to claim 16 and new claim 21 can be found at least at paragraph 0057 of the publication of Applicant's specification (US 20020004/0093053).

Objection to the Claims

Claims 16-20 were objected to because of informalities which were specifically noted in the Office Action. These inadvertent typographical errors were corrected in the amendments to claims 16, 17, and 20. Withdrawal of this objection is therefore respectfully requested.

Rejection of the Claims over Machek

Claim 16 has been rejected under 35 U.S.C. § 102 by Machek, U.S. Patent No. 5,954,761. Applicant respectfully traverses this rejection.

Although Applicant does not necessarily concede the correctness of this rejection, claim 16 has been amended. In order to anticipate a claim, the reference must disclose each and every element of the claim. Applicant respectfully submits that Machek fails to disclose at least one element of amended claim 16.

Claim 16 has been amended to specify that "the lead body and the elongated mesh electrode are dimensioned such that the lead has a common outer diameter throughout its length". The lead that is disclosed by Machek does not have a lead that has a common outer diameter throughout its length. The structure that the Office Action asserts is equivalent to the mesh electrode is the stent (40A or 40B) that as stated by Machek "may be self-expanding or they may be expanded using balloons" (Machek, column 4, lines 10-12). The stents 40A or 40B are also depicted as having a larger diameter than the lead body (see any of Figures 1, 3, 7, 9, 10, 11, 12, or 13). Based on this disclosure Applicant respectfully asserts that Machek fails to disclose a lead where "the lead body and the elongated mesh electrode are dimensioned such that the lead has a common outer diameter throughout its length" as is recited in amended claim 16. Therefore, Applicant respectfully asserts that claim 16 is not anticipated by Machek. Accordingly, withdrawal of this rejection is respectfully requested.

Although not specifically raised in the Office Action, Applicant also respectfully asserts that Machek does not render claim 16 obvious. One of skill in the art, given the disclosure of Machek would not have been motivated to modify the device of Machek to make the lead body and the elongated mesh electrode dimensioned such that the lead has a common outer diameter throughout its length”, because it would render the device of Machek unusable for its intended purpose. According to MPEP § 2143.01(V), there can be no motivation to modify a reference if the proposed modification would render the device unusable for its intended purpose. One purpose of the stent (40A or 40B) in Machek is to act as the structure that retains the distal end of the lead assembly at the selected position (Machek, column 4, lines 34-38). It is also stated that stents “expand to contact the inner surface of a body vessel once the lead has been properly positioned” (Machek, Abstract). If the stents were modified to make them the same size as the lead body, they would no longer function to maintain the lead within the vessel in which it was placed. Based at least on this, Applicant respectfully asserts that Machek does not render claim 16 obvious.

Claims 17-19 have been rejected under 35 U.S.C. § 102(b) and or (e) as anticipated by, or in the alternative under 35 U.S.C. § 103 as obvious over Machek. Applicant respectfully traverses this rejection.

Applicant reiterates the comments offered above with respect to claim 16 and respectfully asserts that at least because of these reasons, claims 17-19 are not obvious over Machek. In light of the amendment to claim 16 and these comments, Applicant respectfully requests that this rejection be withdrawn.

Claim 20 has been rejected under 35 U.S.C. § 103(a) by Machek, U.S. Patent No. 5,954,761. Applicant respectfully traverses this rejection.

Although Applicant does not necessarily concede the correctness of this rejection, claim 16 has been amended. Claim 20 is dependent on claim 16, and therefore Applicant reiterates the comments offered above with respect to claim 16 being non-obvious over Machek; and therefore respectfully asserts that claim 20 is also not obvious. Applicant therefore respectfully requests that this rejection be withdrawn.

Rejection of Claims over Brucker

Claims 16-19 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Brucker et al. (U.S. Patent No. 5,643,197). Applicant respectfully traverses this rejection.

Although Applicant does not necessarily concede the correctness of this rejection, claim 16 has been amended. In order to anticipate a claim, the reference must disclose each and every element of the claim. Applicant respectfully submits that Brucker fails to disclose at least one element of amended claim 16.

Claim 16 has been amended to specify that the mesh electrode has a length from about 10 mm to about 38 mm. Brucker does not disclose a lead that has a mesh electrode (or any equivalent structure) with a length from about 10 mm to about 38 mm. The structure that the Office Action asserts is equivalent to the mesh electrode is the elongated electrode 90 (column 8 generally). Brucker states that the length of the elongated electrode 90 is significantly larger than the length of the ring electrodes, and is generally from 5 mm to about 5 cm; and is more preferably from 0.5 cm to about 1.5 cm (column 8, lines 58-65). Therefore, Brucker does not anticipate claim 16 which recites a mesh electrode that has a length from about 10 mm to about 38 mm. Applicant therefore respectfully requests that this rejection be withdrawn.

Although not specifically raised in the Office Action, Applicant also asserts that Brucker does not render claim 16 obvious. One of skill in the art, given the disclosure of Brucker would not have been motivated to modify the device of Brucker to make the mesh electrode have a length from about 10 mm to about 38 mm, because it would render the device of Brucker unusable for its intended purpose. According to MPEP § 2143.01(V), there can be no motivation to modify a reference if the proposed modification would render the device unusable for its intended purpose. The device of Brucker is an ablation catheter that is utilized to create lesions in biological tissue. It is stated that the length of the elongated electrode is selected to produce the size of the linear lesion appropriate for the treatment of the patient (column 8, lines 60-62). Therefore, one of skill in the art would not have been motivated to modify the catheter of Brucker by making the elongated electrode shorter because it would make the lesion smaller. Furthermore, from the disclosure of Brucker, the elongated electrode is preferably between about 0.5 cm and 1.5 cm; therefore, one of skill in the art would not have been motivated to decrease that preferred length by a factor of almost 10 because the lesion size that would be created would be decreased similarly.

Based at least on the comments provided above, claim 16 is not obvious over Brucker.

Rejection of Claims over Spreigl

Claims 16-18 have been rejected under 35 U.S.C. § 102 by Spreigl, U.S. Patent No. 6,161,029. Applicant respectfully traverses this rejection.

Although Applicant does not necessarily concede the correctness of this rejection, claim 16 has been amended. In order to anticipate a claim, the reference must disclose each and every element of the claim. Applicant respectfully submits that Spreigl fails to disclose at least one element of amended claim 16.

Claim 16 has been amended to specify that “the lead body and the elongated mesh electrode are dimensioned such that the lead has a common outer diameter throughout its length”. The lead that is disclosed by Spreigl does not have a lead that has a common outer diameter throughout its length. The structure that the Office Action asserts is equivalent to the mesh electrode is the retention stent 30. The retention stent 30 has an expanded stent state which is approximately equal to or exceeds the inner diameter of the vessel lumen that functions to lodge the stent against the blood vessel wall and inhibit movement of the stent and the distal electrode support (column 10, lines 39-52). Based on this disclosure Applicant respectfully asserts that Spreigl fails to disclose a lead where “the lead body and the elongated mesh electrode are dimensioned such that the lead has a common outer diameter throughout its length” as is recited in amended claim 16. Therefore, Applicant respectfully asserts that claims 16-18 are not anticipated by Spreigl. Accordingly, withdrawal of this rejection is respectfully requested.

Although not specifically raised in the Office Action, Applicant also respectfully asserts that Spreigl does not render claims 16-18 obvious. One of skill in the art, given the disclosure of Spreigl would not have been motivated to modify the device of Spreigl to make “the lead body and the elongated mesh electrode dimensioned such that the lead has a common outer diameter throughout its length”, because it would render the device of Spreigl unusable for its intended purpose. According to MPEP § 2143.01(V), there can be no motivation to modify a reference if the proposed modification would render the device unusable for its intended purpose. The purpose of the stent 30 in Spreigl is to retain the stent and the entire lead in the vessel in which it is placed (Abstract) If the stents were modified to make them the same size as the lead body, they would no longer function to maintain the lead within the vessel in which it was placed.

Based at least on this, Applicant respectfully asserts that Spreigl does not render claims 16-18 obvious.

Claims 19 and 20 have been rejected under 35 U.S.C. § 103 as being obvious over Spreigl, U.S. Patent No. 6,161,029. Applicant respectfully traverses this rejection.

Applicant reiterates the comments offered above with respect to claims 16-18 and respectfully asserts that at least because of these reasons, claims 19 and 20 are not obvious over Spreigl. In light of the amendment to claim 16 and these comments, Applicant respectfully requests that this rejection be withdrawn.

In view of the foregoing amendments, Applicants respectfully request reconsideration and allowance of the claims as all rejections have been overcome. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 651.259.6702 or by E-mail at anelson@cnwiplaw.com with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 50-3964.

Respectfully submitted,

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